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REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the following remarks.

Claims 1-15 and 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 5,309,504 to Morganstein (hereinafter "Morganstein"). Claims 1, 8, 9, and 19 are the independent claims. Applicant respectfully traverses this rejection.

Anticipation under 35 U.S.C. § 102 requires that a reference teach each and every aspect of the claimed invention. M.P.E.P. § 2131. Applicant respectfully submits that Morganstein does not teach each and every element of the present invention.

Claims 1 and 9 are system claims, and claims 8 and 19 are method claims. The Applicant's independent claims, as amended, contain the limitations of a system having "means for populating an automatic number identifier (ANI) for each outside call, with a telephone number or extension of a port that received the telephone signal, handled by said IVR not having an ANI and associating said ANI therewith" or a method having the step of "populating an automatic number identifier (ANI) for each outside

call, with a telephone number or extension of a port that received the telephone signal, handled by said IVR not having an ANI and associating the ANI therewith," which are not found in the Morganstein.

The Examiner states that "[r]egarding 'means for populating [sic] ANI therewith', Morganstein teaches on step 122 Fig. 4a. When the result of step 122 is 'NO', it is the claimed 'each outside call handled by said IVR not having an ANI'. Morganstein also teaches on step 178 'store caller ident. information' (reads on claimed 'populating an automatic number identified')." (Office Action, dated May 8, 2003, Page 3). However, this is an incorrect reading of Morganstein. Morganstein teaches that when the result of step 122 is "YES", the next step is "(BLOCK 178)". (see Morganstein, Fig. 4a, YES, 124, (BLOCK 178)). Also, the lead line leading into just above step 178 is the detected ANI number. This "store caller ident. information" step (step 178) stores the detected ANI number. Further, Morganstein discloses that if an ANI number is detected "the ANI number, if forwarded by such facilities, is also stored as a caller identification number." (emphasis added) (Col. 11, lines 39-40). Alternatively, Morganstein discloses that if an ANI

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number is not detected, "the calling party identification information [that] is either keyed in by his or her touch tone keypad or spoken by words" and stored in the caller identification information block. Morganstein only discloses ANI equipment for identifying the calling party (Col. 3, lines 50 et seq.).

As explained in the Applicant's Background of the Invention, "in a call center where the ports on a voice response unit are not defined as extensions on a PBX, when a call arrives at a voice response unit port, even if the voice response unit collects data and transmits the data and the port to the call center management system, the call center management system will not know about the call since it is not on a defined extension. Accordingly, what is needed is a voice response unit interface for correlating and associating data gathered by the voice response unit with a call regardless of the manner in which the voice response unit is connected to a call center management system." (Page 7, paragraph 15). Applicant claims such a system and method, and Morganstein does not disclose this. Reconsideration is respectfully requested.

Claims 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morganstein and in view of United States Patent

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No. 6,301,480 to Kennedy et al. (hereinafter "Kennedy et al.").

Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation in the reference itself to modify the reference or to combine reference teachings. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. M.P.E.P. § 2143, *citing, In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant submits that the Examiner has not established a *prima facie* case of obviousness. Rather, the Examiner has made general conclusions that "it would have been obvious to one skilled at the time the invention was made to modify . . . " (Office Action, dated May 8, 2003, pages 7-8). This is not the test or elements for a *prima facie* case of obviousness, and

reconsideration is respectfully requested.

In addition to the arguments discussed above with regard to the 35 U.S.C. § 102 rejection, which is hereby incorporated by reference, Applicant additionally submits that the combination of Morganstein and Kennedy et al. is improper because there is no motivation to combine the references. The Examiner does not discuss the motivation to combine the references.

Morganstein discloses a system for the automated identification of attendant positions in a telecommunication system, whereas Kennedy et al. discloses a system and method for communicating using a voice network and a data network. It is improper to combine Morganstein and Kennedy et al. simply because the two references deal, generally, with telecommunications. MPEP § 2143.01 states, in relevant part, that the Examiner must show WHERE in the prior art can be found a "clear suggestion" that the claimed combination is obvious. This requirement is in addition to the requirement that the references must be analogous art. Applicant submits that the Examiner has failed to show where in the prior art there can be found a "clear suggestion" that the claimed combination is obvious.

In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16

USPQ 2d 1923 (Fed. Cir. 1990), the Appellant argued that the district court misapplied the Section 103 nonobviousness standard "by adopting an overly stringent test" that required "that the claimed combination be "clearly suggested" by the prior art in order to be obvious." 16 USPQ2d at 1926.

The Federal Circuit found no reversible error stating:

"[In] *Kimberly-Clark [Corp. v. Johnson & Johnson]*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984)], not only did we 'fail to find a clear suggestion of the claimed subject matter,' ... we found 'not the slightest suggestion' in the art of the claimed dual function adhesive...".

As to whether "clear suggestion" is a proper test of obviousness, we note initially that *Kimberly-Clark* is not the only instance in which we have made use of that phrase in a discussion of obviousness. Various other formulations of the requisite level of suggestion for combining prior art disclosures have been set forth in our precedent.

We need not decide here whether "clear suggestion" is an overly rigorous test for obviousness, however ... [T]his court independently reviews obviousness determinations. In reaching our own conclusion regarding obviousness, we need not give deference to a particular analytical construct utilized in a district court's opinion. Our task is to review the district court's judgment." 16 USPQ2d at 1926-27.

In *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992), the court reiterated that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not

come from the applicant's invention itself." 24 USPQ2d at 1446.

Accordingly, since the Examiner has failed to present a *prima facie* case of obviousness of the pending claims and has failed to show a "clear suggestion" in the prior art itself for combining the art to render obvious applicant's claimed combination, Applicant submits that the rejection of the pending claims is improper and should be withdrawn.

Conclusion

In view of the foregoing remarks, Applicant submits that all of the pending claims are in condition for allowance and requests early and favorable action on the merits.

The Examiner is invited to telephone the undersigned, applicant's attorney of record, to facilitate advancement of the present application.

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Respectfully submitted,

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